UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,466	03/27/2001	Sean Lee	099866/9	1836

7590 10/09/2002

KRAMER LEVIN NAFTALIS & FRANKEL LLP
919 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER
SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,466	Applicant(s) LEE ET AL.	
	Examiner Humera N Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2002 (paper no.9)* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-134* is/are pending in the application.

4a) Of the above claim(s) *27-89,95-98,104-119 and 122-134* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26, 90-94, 99-103 and 120-121* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Status of the Application

Acknowledgement is made of the receipt of the request for an Extension of Time (1 month) and the Amendment filed 07/03/02.

Applicant's election with traverse of the invention of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the claims of Groups I and II are all related to the same subject matter and the examination of Group II along with Group I would not impose an undue burden on the examiner. This is not found persuasive because the claims of Group II are distinct from the claimed subject matter of Group I, in that they contain distinct components (buffer) that may alter the cosmetic formulation, and hence would require an extended or separate search for examination.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-26, 90-94, 99-103 and 120-121 are pending. Claims 1-26, 90-94, 99-103 and 120-121 are rejected.

Claims 27-89, 95-98, 104-120 and 122-134 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected subject matter, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9 (filed 07/03/02).

Claim Objections

Claims 12, 13, 25 and 26 are objected to because of the following informalities:

A series of singular dependent claims is permissible in which a dependent claim refers to a *preceding* claim which, in turn, refers to another *preceding* claim.

A claim, which depends from a dependent claim, should not be separated by any claim, which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 6-13, 14 and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claims 1, 14, 93, 102 and 120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 93, 102 and 120 contain the trademark/trade names Pemulen® TR-2 and Lubrajel® MS. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe gels and bases in various cosmetic forms and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimono *et al.* (US Pat. No. 5, 290,544, collectively, "Shimono").

Shimono disclose cosmetic products comprising soluble glass, that may be heat-derived or sol-gel derived, wherein the cosmetic products are free from or do not contain water (see reference column 1, lines 1-68 through col. 2, lines 1-55); (claims and abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-26, 90-94, 99-103, 120 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimono *et al.* (US Pat. No. 5, 290,544, collectively, "Shimono").

As pointed out above, Shimono teaches cosmetic products comprising soluble glass, that may be heat-derived or sol-gel derived, wherein the cosmetic products are free from or do not contain water (see reference column 1, lines 1-68 through col. 2, lines 1-55); (claims and abstract). The cosmetic products contain soluble glass with metal ions, which provide antibacterial and antimold effects with a high degree of safety (col. 2, lines 27-30). Shimono teaches that the soluble glass may be manufactured by any method, such as heating the glass to be vitrified or alternatively, by a sol-gel method (col. 1, lines 62-68). The cosmetic products are used in the form of a liquid, cream or powder. Liquid formulations comprise liquid foundation, skin lotion, milky lotion, shampoo, hair rinse, etc. Cosmetic formulations comprising solid materials that do not contain water consist of powder foundation, eye shadow, lipstick, body powder, baby powder, etc (col. 2, lines 45-55). The soluble glass may be pulverized into a powder having an average particle size of 20 microns or less, preferably 5 microns or less (col. 2, lines 56-60). The soluble glass comprise silicone dioxide oxide (SiO_2), sodium oxide (Na_2O), calcium oxide (CaO), phosphorous oxide (P_2O_5), talc, silicone treated titanium dioxide, various iron oxides – (red, yellow, black), mica, liquid paraffin,

and glycerin (see examples and claims). Additionally, B_2O_3, Al_2O_3, MgO and K_2O may be comprised in the soluble glass formulation (claims 3-6).

The instant invention is drawn to a cosmetic composition comprising bioactive glass and a substantially anhydrous cosmetic formulation, wherein the bioactive glass is melt-derived, sol-gel derived and an aqueous extract. Shimono teaches cosmetic compositions comprising soluble glass, wherein the cosmetics are in solid form and free of water i.e., powder foundation, eye shadow, lipstick, etc, and comprise soluble glass made by heating or sol-gel derived methods wherein the glass has moisture absorbing properties (col. 2, lines 49-55). There is no significant difference observed between the prior art and the instant invention. Furthermore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to incorporate soluble glass into a cosmetic formulation because it could impart a beneficial role in contributing to the desired objective of achieving effective antibacterial and antimold properties while providing a high degree of safety. The expected result would be a bacteria-free, non-irritating cosmetic product.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600